

Docket No. AB-124U1

Remarks

Applicants acknowledge and appreciate the Examiner's indication that claims 12, 14, 18, 25-30, 32, 36 and 43-48 contain allowable subject matter. By way of the present amendment, applicants have canceled claims 9, 12, 13 and 31 and have amended claims 1, 10, 11, 14, 15, 25, 30, 32, 33, 43 and 48. Forty-four (44) claims remain pending in the application, claims 1-8, 10, 11, 14-30 and 32-48, of which claims 1, 14, 25, 32 and 43 are independent. Applicants respectfully request reconsideration of the pending claims, in view of the amendments above and comments below.

Allowable Subject Matter

Applicants acknowledge with appreciation that, on pages 5-6 of the Office action mailed June 14, 2004, the Examiner indicated that claims 14, 18, 25-30, 32, 36 and 43-48 contain allowable subject matter. These claims were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As seen from the amendments *supra*, applicants have rewritten claims 14, 25, 32 and 43 as suggested. Claim 12 was rejected under 35 U.S.C. 112, second paragraph, but was considered allowable if the claim was rewritten to overcome this rejection and to include all of the limitations of the base claim and any intervening claims. The subject matter of claim 12 has been added to claim 1, and the antecedent basis problem has been addressed via amendment.

Application No. 09/927,757
Amendment A dated September 14, 2004
Reply to Office Action dated June 14, 2004

Page 10 of 14

Docket No. AB-124U1

Claim Rejections - 35 U.S.C. § 112

On page 2 of the Office action mailed June 14, 2004, claim 12 was rejected under 35 U.S.C. 112, second paragraph, for reciting the limitation "the sensed condition" without sufficient antecedent basis. As stated above, applicants have amended claim 1 to incorporate the limitation of claim 12 and intervening claim 9, and to provide proper antecedent basis for "the sensed condition".

Claim Rejections - 35 U.S.C. § 102 & 103

On pages 2-5 of the Office action, claims 1-11, 13, 15-17, 19-24, 31, 33-35 and 37-42 were rejected – some under 35 U.S.C. 102(b) or in the alternative, under 35 U.S.C. 103(a), and some solely under 35 U.S.C. 103(a), over various combinations of five pieces of art.¹

Once again, by way of the present amendment, claim 1 has been amended to incorporate the subject matter of claim 12, which was considered by the Examiner to be "allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph...and to include all the limitations of the base claim and any intervening claims."

¹ Claims 13, 15, 17, 24, 31, 33-35, 39 and 42 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as unpatentable over Creasy "Electrical Stimulation of Sacral Roots for Micturition after Spinal Cord Injury" ("Creasy"); claims 13, 15-17, 21 24, 31, 33-35, 39 and 42 were rejected under 35 U.S.C. 103(a) as unpatentable over Tai et al "Penile Erection Produced by Microstimulation of the Sacral Spinal Cord of the Cat" ("Tai et al") further in view of Cameron et al "Micromodular Implants to Provide Electrical Stimulation of Paralyzed Muscles and Limbs" ("Cameron et al"), or Creasy, or Meloy et al USPN 6,169,924 ("Meloy et al"); claims 19-20, 22-23, 34-35, 37-38 and 40-41 were rejected under 35 U.S.C. 103(a) as unpatentable over Creasy, or alternatively Tai et al further in view of Cameron et al, or Creasy, or Meloy et al, either in view of Leu et al "Electrostimulation and Penile Erection" ("Leu et al") or Meloy et al; claims 1-6 and 9-11 were rejected under 35 U.S.C. 103(a) as unpatentable over Creasy or Tai et al either in further view of Cameron et al; and claims 7-8 were rejected under 35 U.S.C. 103(a) as unpatentable over Creasy or Tai et al either in further view of Cameron et al and further in view of Meloy et al or Lue et al.

Docket No. AB-124U1

By adding the allowable subject matter of claim 12 (and intervening claim 9) to claim 1, applicants have, in effect, "include[d] all of the limitations of the base claim and any intervening claims" with the allowable subject matter. Also, as described above, applicants have amended the claim to include antecedent basis for "the sensed condition." As such, applicant believes amended claim 1 is allowable. Acknowledgment of the same is earnestly solicited.

Claims 2-8 remain dependent on claim 1 and **claims 10 and 11** have been amended to depend from claim 1. Since these claims depend directly from independent claim 1 (allowable based on the aforementioned amendments) and further limit the claim from which they depend, **claims 2-8, 10 and 11** should also be allowable. Applicants respectfully request acknowledgment of the same.

Claims 9, 12 and 13 have been canceled, rendering rejection thereto moot.

Claim 14, which was considered by the Examiner to be "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims," has been so amended to incorporate all the limitations of claim 13, from which it depended. **Claims 15-24** depend, directly or indirectly, from now-independent claim 14, so should also be allowable.

Claim 25, which was considered by the Examiner to be "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims," has been so amended to incorporate all the limitations of claim 13, from which it depended. **Claims 26-30** depend, directly or indirectly, from now-independent claim 25, so should also be allowable.

Docket No. AB-124U1

Claim 32, which was considered by the Examiner to be "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims," has been so amended to incorporate all the limitations of claim 31, from which it depended. (Claim 31 has been canceled.) **Claims 33-42** depend, directly or indirectly, from now-independent claim 32, so should also be allowable.

Claim 43, which was considered by the Examiner to be "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims," has been so amended to incorporate all the limitations of claim 31, from which it depended. **Claims 44-48** depend, directly or indirectly, from now-independent claim 14, so should also be allowable.

As seen above, the dependency of claims 10, 11, 15, 30, 33 and 48 has been amended, as these claims originally depended from a now-canceled claim, and claims 30 and 48 have been further amended to ensure proper antecedent basis after the dependency change. No new matter has been added by any of the claim amendments above.

Applicants respectfully assert based on the foregoing that claims 1-8, 10, 11, 14-30 and 32-48 are in condition for allowance. Acknowledgment of the same is earnestly solicited.

Docket No. AB-124U1

Conclusion

In view of the foregoing, it is respectfully submitted that the rejections have been overcome and the pending claims are in condition for allowance. An indication of allowability of pending claims 1-8, 10, 11, 14-30 and 32-48 at an early date is earnestly solicited.

The Examiner is invited to telephone the undersigned, Laura Bishop, at his convenience should any issues remain after consideration and entry of this response, in order to permit early resolution of the same.

Respectfully Submitted,

2004 Sept 14
Date

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Application No. 09/927,757
Amendment A dated September 14, 2004
Reply to Office Action dated June 14, 2004

Page 14 of 14